



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,345	08/09/2000	Albert K. Chin	AKC-22900 [R0171]	5920

7590 03/16/2006
ALBERT C. SMITH
FENWICK & WEST LLP
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER

BARRETT, THOMAS C

ART UNIT PAPER NUMBER

3738

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/635,345	Applicant(s) CHIN, ALBERT K.	
	Examiner Thomas C. Barrett	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 12, 13, 15-22, 24 and 28-40 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 12, 13, 15-22, 28-33, 38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 34-37 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1-06, 5-05, 7-05, 11-05, 12-05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 24, 34-37 and 40 have been considered but are moot in view of the new ground(s) of rejection.

In regards to claims 40 and 24, the Applicant has failed to distinctly point out how the claims are patentable over the prior cited art.

In regards to claims 34-37, the Applicant argues that aspects of the claimed invention promote mechanical expansion of the outer sheath in response to movement therethrough of a surgical tool positioned therein, and that these aspects are not disclosed or suggested by the prior cited art. However, as noted in prior office actions, Hildwein et al. discloses a laterally-expandable sheath. As can be seen in figures 1-16B, passing of tools through the flexible sheath of Hildwein et al. promote mechanical expansion inherently dilates adjoining tissue.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,033,477) in view of Kieturakis (5,569,183), in further view of Hildwein et al. (5,391,156). Chin '477 discloses a method of performing a cardiac procedure through a subxiphoid incision and gripping a flap of the pericardium using an instrument and

cutting said flap of the pericardium while spaced away from the underlying heart (Fig. 7) however fails to disclose the procedure under endoscopic visualization. Kieturakis teaches the use of a rigid endoscopic cannula having a transparent tip and an access extending to an open distal end (Fig. 1), for developing a "minimally invasive" accessway to the interior of the body (col. 1, lines 47-53). It would have been obvious to one of ordinary skill in the art to combine the teaching of a rigid endoscopic cannula having a transparent tip, as taught by Kieturakis, to disclose a method of performing a cardiac procedure through a subxiphoid incision as per Chin et al., for developing a "minimally invasive" accessway to the interior of the body. However Chin '477 fails to disclose laterally expanding a sheath responsive to passing the endoscopic cannula. Hildwein et al. teaches a laterally expanding sheath (Figs. 16A-B) which provides a relatively wide range of angular displacement (col. 8, lines 6-9). It would have been obvious to one of ordinary skill in the art to combine the teaching of a laterally expanding sheath, as taught by Hildwein et al., to a method of performing a cardiac procedure using an endoscopic cannula as per Chin '477, in order to provide a relatively wide range of angular displacement. Please Note: The passing of tools through the flexible sheath of Hildwein et al. inherently dilates adjoining tissue.

Claims 24 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,033,477) in view of Kieturakis (5,569,183) as above, in further view of Vaska et al. (6,237,605 B1). Chin '477 discloses a method of performing a cardiac procedure through a subxiphoid incision and gripping a flap of the pericardium using an instrument and cutting said flap of the pericardium while spaced away from the

Art Unit: 3738

underlying heart (Fig. 7) however fails to disclose the procedure under endoscopic visualization. Kieturakis teaches the use of a rigid endoscopic cannula having a transparent tip and an access extending to an open distal end (Fig. 1), for developing a "minimally invasive" accessway to the interior of the body (col. 1, lines 47-53). It would have been obvious to one of ordinary skill in the art to combine the teaching of a rigid endoscopic cannula having a transparent tip, as taught by Kieturakis, to disclose a method of performing a cardiac procedure through a subxiphoid incision as per Chin et al., for developing a "minimally invasive" accessway to the interior of the body. However Chin '477 fails to disclose using the cannula for a cardiac mapping procedure. Vaska et al. teaches the mapping of the conduction pathways of the heart within the pericardium for the diagnosis of electrophysiological disorders (Figs. 8 and 9). It would have been obvious to one of ordinary skill in the art to combine the teaching of the mapping of the conduction pathways of the heart, as taught by Vaska et al., to a method of performing a cardiac procedure using an endoscopic cannula as per Chin '477, in order to for the diagnosis of electrophysiological disorders. Please Note: The process of cardiac mapping inherently involves a sweeping motion of the device over the anterior and posterior of the heart.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Thomas Barrett". The signature is fluid and cursive, with a large initial "T" and a long, sweeping underline.

Thomas Barrett
Examiner
Art Unit: 3738